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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,697	09/29/2003	Jean-Yves Bonnefoy	1430-287	7814

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EXAMINER	
BASI, NIRMAL SINGH	
ART UNIT	**PAPER NUMBER**
1646	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,697	BONNEFOY ET AL.	
	Examiner	Art Unit	
	Nirmal S. Basi	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2003*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-22* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects in so far as the disease is characterized by IgE differentiation, wherein the disease is selected from the group consisting of a respiratory disorder, atopy, atopic dermatitis, an allergy, rhinitis and eczema, which method comprises administration to a patient of a polypeptide comprising SEQ ID NO:9 or soluble form thereof, classified in class 514, subclass 2.

II. Claims 1-6 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects in so far as the disease is characterized by IgE differentiation, wherein the disease is AIDS, which method comprises administration to a patient of a polypeptide comprising SEQ ID NO:9 or soluble form thereof, classified in class 514, subclass 2.

III. Claims 1-6 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects in so far as the disease is characterized by Th2 differentiation, wherein the disease is selected from the group consisting of a respiratory disorder, atopy,

atopic dermatitis, an allergy, rhinitis and eczema, which method comprises administration to a patient of a polypeptide comprising SEQ ID NO:9 or soluble form thereof, classified in class 514, subclass 2.

IV. Claims 1-6 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects in so far as the disease is characterized by Th2 differentiation, wherein the disease is AIDS, which method comprises administration to a patient of a polypeptide comprising SEQ ID NO:9 or soluble form thereof, classified in class 514, subclass 2.

V. Claims 7, 9-12 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by IgE differentiation, wherein the disease is selected from the group consisting of a respiratory disorder, atopy atopic dermatitis, an allergy, rhinitis and eczema which method comprises administration to a patient of a soluble polypeptide which is capable of binding human IL13 and/or human IL4 in the presence of IL4Ra or which is bound to human IL13 and/or human IL4 which comprises the amino acid sequence shown in SEQ ID NO:9., classified in class 514, subclass 2.

VI. Claims 7, 9-12 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by IgE differentiation, wherein the

disease is AIDS which method comprises administration to a patient of a soluble polypeptide which is capable of binding human ILI3 and/or human IL4 in the presence of IL4Ra or which is bound to human IL13 and/or human IL4 which comprises the amino acid sequence shown in SEQ ID NO:9., classified class 514, subclass 2.

VII. Claims 7, 9-12 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by Th2 differentiation, wherein the disease is selected from the group consisting of a respiratory disorder, atopy, atopic dermatitis, an allergy, rhinitis and eczema which method comprises administration to a patient of a soluble polypeptide which is capable of binding human ILI3 and/or human IL4 in the presence of IL4Ra or which is bound to human IL13 and/or human IL4 which comprises the amino acid sequence shown in SEQ ID NO:9, class 514, subclass 2.

VIII. Claims 7, 9-12 and 15-18, drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by Th2 differentiation, wherein the disease is AIDS which method comprises administration to a patient of a soluble polypeptide which is capable of binding human ILI3 and/or human IL4 in the presence of IL4Ra or which is bound to human IL13 and/or human IL4 which comprises the amino acid

sequence shown in SEQ ID NO:9, classified in class 514, subclass 2.

IX. Claims 8-12 and 15-18 drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by IgE differentiation, wherein the disease is selected from the group consisting of respiratory disorder, atopy, atopic dermatitis, an allergy, rhinitis and eczema, which method comprises administration to a patient of a soluble polypeptide which comprises the amino acid sequence shown in SEQ ID NO:9 wherein the Thr residue number 130 and the Gly residue number 358 shown in SEQ ID NO:9 are replaced by Ile and Asp residues, respectively classified in class 514, subclass 2.

X Claims 8-12 and 15-18 drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by IgE differentiation, wherein the disease is AIDS, which method comprises administration to a patient of a soluble polypeptide which comprises the amino acid sequence shown in SEQ ID NO:9 wherein the Thr residue number 130 and the Gly residue number 358 shown in SEQ ID NO:9 are replaced by Ile and Asp residues, respectively classified in class 514, subclass 2.

XI. Claims 8-12 and 15-18 drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by Th2 differentiation, wherein the disease is selected from the group consisting of respiratory disorder, atopy, atopic dermatitis, an allergy, rhinitis and eczema, which method comprises administration to a patient of a soluble polypeptide which comprises the amino acid sequence shown in SEQ ID NO:9 wherein the Thr residue number 130 and the Gly residue number 358 shown in SEQ ID NO:9 are replaced by Ile and Asp residues, respectively classified in class 514, subclass 2.

XII. Claims 8-12 and 15-18 drawn to a method of treatment of a disease in which IL13 and IL4 cause adverse effects, in so far as the disease is characterized by Th2 differentiation, wherein the disease is AIDS, which method comprises administration to a patient of a soluble polypeptide which comprises the amino acid sequence shown in SEQ ID NO:9 wherein the Thr residue number 130 and the Gly residue number 358 shown in SEQ ID NO:9 are replaced by Ile and Asp residues, respectively classified in class 514, subclass 2.

XIII. Claim 19 drawn to a method of decreasing IL13 and/or IL4 levels in a patient's body, which method comprises administration to a patient of a soluble polypeptide comprising SEQ ID NO:9, classified in class 514, subclass 2.

XIV. Claim 20 drawn to a method of decreasing IL13 and/or IL4 levels in a patient's body, which method comprises administration to a patient of a soluble polypeptide comprising SEQ ID NO:9 wherein the Thr residue number 130 and the Gly residue number 358 shown in SEQ ID NO:9 are replaced by Ile and Asp residues, respectively., classified in class 514, subclass 2.

XV. Claim ~~14~~ 13 drawn to a composition comprising a soluble polypeptide comprising SEQ ID NO:9, classified in class 530, and subclass 350.

XVI. Claim ~~15~~ 14 drawn to a composition comprising a soluble polypeptide comprising SEQ ID NO:9 wherein the Thr residue number 130 and the Gly residue number 358 shown in SEQ ID NO:9 are replaced by Ile and Asp residues, respectively, class 530, subclass 350.

XVII. Claims 21-22 drawn to an antibody fragment, or a synthetic construct thereof which is capable of binding to a polypeptide comprising SEQ ID NO:9 or a polypeptide comprising SEQ ID NO:9 wherein the Thr residue number 130 and the Gly residue number 358 shown in SEQ ID NO:9 are replaced by Ile and Asp residues, respectively., classified in class 530, subclass 387.9.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions XV and I-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in

a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product of invention XV can be used to make antibodies.

3. Inventions XVI and VIII-XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product of invention XVI can be used to make antibodies.

4. Inventions XV-XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions the invention of XV-XVII are structurally and functionally different compounds capable of separate use and manufacture. In the instant case the product of inventions XV-XVII can be all used to make different antibodies.

5. Inventions XVII and I-XIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the antibodies of Invention XVII can neither be used or made by the methods of groups I-XIV.

6. Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the

instant case, the different inventions use different modes of action different compound and have different effects (i.e. treat different diseases).

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Species Election

This application contains claims directed to the following patentably distinct species: respiratory disorder, atopy, atopic dermatitis, an allergy, rhinitis and eczema. The species are independent or distinct because they relate to different diseases with different etiologies.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 7 and 8 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR

1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship

must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Advisory

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal S. Basi whose telephone number is 571-272-0868. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nirmal S. Basi
Art Unit 1646
6/23/06

ROBERT S. LANDSMAN, PH.D.
PRIMARY EXAMINER